

REMARKS

Claims 1-18 are pending in the present application.

Claims 1-4, 8-10, 12, 13, 17 and 18 are rejected.

Claims 5-7, 11 and 14-16 are objected to, but recite allowable subject matter.

Claims 1-4, 6-8, 13, 14 and 16 have been amended, and Claims 5, 11 and 15 have been canceled.

Reconsideration of the claims is respectfully requested.

The indication that Claims 5-7, 11 and 14-16 recite allowable subject matter is noted with appreciation. The limitations of allowable subject matter Claims 5, 11 and 15 have been incorporated into their respective parent Claims 1, 8 and 13, and allowable subject matter Claims 6, 7, 14 and 16 have been rewritten in independent form. Accordingly, independent Claims 1, 6-8, 13, 14 and 16 should be in condition for allowance, together with Claims 2-4 which depend from allowable Claim 1, and Claims, 9, 10 and 12 which depend from allowable Claim 8. Minor amendments have been made in various ones of the aforementioned allowable claims in order to improve their form.

The only remaining issue is the patentability of Claims 17 and 18. Claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamawaki U.S. Patent No. 4,894,707 in view of Hirai U.S. Patent No. 5,384,286. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468,

1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Claims 17 and 18 are drawn to a mold for packaging integrated circuits, including a surface against which a lead frame strip may be placed. The surface includes a plurality of cavity regions, each cavity region receiving an integrated circuit die and bond wires when the lead frame strip is placed against the surface. Each cavity region is formed by "a first surface contacting a surface region of the integrated circuit die . . . when the lead frame strip is placed against the surface and preventing

encapsulate material from adhering to the surface region of the integrated circuit die". The above-quoted feature of Claims 17 and 18 has not been found to be disclosed in Yamawaki as alleged in the pending office action.

Referring now to Yamawaki Figure 5e, no part of the mold 21, 22 ever contacts any part of the integrated circuit chip 1. Rather, the mold portion 21 contacts a silicone rubber wall 3 that has been deposited on the chip 1 by a screen-printing process. See Yamawaki at column 1, lines 20-22 and 36-39; column 2, lines 63-65; and column 3, lines 4-8. The contact of the mold portion 21 to the wall 3 prevents molding resin from entering the empty space 25 located inside the wall 3, below the mold portion 21, and above the chip 1.

It is submitted in view of the foregoing that Yamawaki fails to teach or even suggest the above-quoted feature of Claims 17 and 18. Furthermore, Hirai has not been found to teach or suggest the above-quoted feature of Claims 17 and 18, and the office action does not allege otherwise. Accordingly, the office action fails to establish a *prima facie* case of obviousness with respect to Claims 17 and 18. Therefore, the rejection of Claims 17 and 18 under 35 U.S.C. § 103 has been overcome.

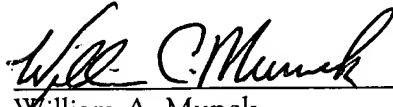
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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